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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------|------------------|
| 10/019,752 | 12/27/2001 | Jun Sugawara | 11728/4 | 8825 |
| 26646 | 7590 | 02/02/2004 | EXAMINER | |
| KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004 | | | FIORILLA, CHRISTOPHER A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1731 | |

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,752

Applicant(s)

SUGAWARA ET AL.

Examiner

Christopher A. Fiorilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10, 14 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) 2, 14, 17, 19, 21, 24 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 16, 18, 20, 22, 23, 25 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. Applicant's election with traverse of species "a" in Paper dated 10/31/03 is acknowledged. The traversal is on the ground(s) that the claims are sufficiently related to be properly presented in a single application. This is not found persuasive because the species have separate special technical features as set forth in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 2,14,17,19,21,24 and 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper dated 10/31/03.

3. Claim 3 is objected to because of the following informalities: It is dependent on a nonelected claim. It should be written in independent form. Appropriate correction is required.

4. Claims 1,10,16,18,20,22,23;25 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. See 37 CFR 1.75(i). See MPEP 608.01(m).

The addition of the word "type" to an otherwise definite expression extends the scope of the expression so as to render it indefinite. *Ex Parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955). Claim 28 is indefinite for this reason. See line 5.

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In claim 10, the phrase "the raw material powder" has no antecedent basis.

Claim 25 is indefinite in that it is a method claim which is dependent on a product claim.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 28 recites the broad recitation "SiO₂ type powders", and the claim also recites "(petalite, spodumene, and eucryptite)" which is the narrower statement of the range/limitation.

5. Claims 1,16,18,20,22,23 and 25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a sintered body comprising a single phase of cordierite and optionally additionally a LiO₂-Al₂O₃-SiO₂ crystal phase (see e.g. page 17, first full paragraph), does not reasonably provide enablement for the product as generically claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to produce the invention commensurate in scope with these claims.

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6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 10,27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 403150263A.

JP 403150263A teaches the production of a black sintered body by sintering in a hydrogen containing reducing atmosphere at e.g. 1500°C. Note that the terms “low thermal expansion” and “high specific rigidity” are relative terms and do not distinguish over the reference.

8. Claims 10 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 402074538A.

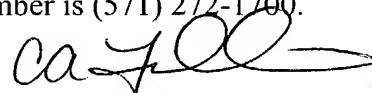
JP 402074538A teaches the production of a black sintered body by sintering in a nitrogen containing reducing atmosphere at e.g. 1300°C. Note that the terms “low thermal expansion” and “high specific rigidity” are relative terms and do not distinguish over the reference.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Fiorilla whose telephone number is (571) 272-1187. The examiner can normally be reached on M-F, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.



Christopher A. Fiorilla
Primary Examiner
Art Unit 1731

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